Objection to the Disclosure

The disclosure is objected to because of an informality. The specification is amended as indicated above to obviate the objection. Withdrawal of the objection is respectfully requested.

Rejection for Obviousness-Type Double Patenting

Claims 1, 2, 4-21, 23 and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-16 of U.S. Patent No. 6,064,653 ('653 patent). It is respectfully submitted that the rejection is improper.

The '653 patent is directed to an internetwork gateway to gateway alternative communication in which voice calls between two end location gateway servers of a data internetwork are diverted during periods of unacceptable conditions through a public switched telephone network PSTN. Claim 1, exemplary of the '653 patent, relates to a method of controlling digital voice communication between a first gateway interfacing a PSTN and a packet data network at a first location and a second gateway interfacing the packet data network and the PSTN at a second location. Voice call signals received at the first gateway and addressed to a destination in the PSTN at the second location are converted to data packets. Data traffic conditions through the packet data network between the first and second locations are monitored. In response to the monitoring step, the data

packets are routed to the second gateway through the PSTN if the monitored conditions are below a predetermined acceptable threshold level. The predetermined acceptable threshold level is a minimum acceptable data flow rate. Monitoring the data traffic conditions includes the steps of transmitting a request packet from the first gateway through the data packet network to the second gateway; receiving a response packet; and, measuring the round trip time duration therebetween.

In contrast, claim 1 of the application is directed to a method for providing voice communication between stations at two remote locations that are each linked to PSTNs. The method includes the steps of determining quality of service of a data packet network in response to placement of a telephone call by a first one of the stations; comparing the quality of service obtained in the determining step with a predetermined threshold level; and, in response to a result in the comparing step that the predetermined threshold level is exceeded, routing the telephone call to a second one of the stations through the data packet network.

It is respectfully submitted that case law has shown that double patenting is sometimes confused with the ability to have dominant claims included in an application and narrow claims directed to a similar invention included in a patent. In this situation, the narrow claims cannot be infringed without infringing the dominant claims of the other patent. The Federal Circuit held in In re Kaplan, 789

F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986) that a double patenting rejection cannot be justified solely on the ground that the subject matter of a claim in a second patent or patent application is "dominated" by claims in a first patent. In reversing the double patenting rejection, the Federal Circuit held:

> By domination, we refer, in accordance with established patent law terminology, to that phenomenon which grows out of the fact that patents have claims whereunder one patent has a broad or "generic" claim which "reads on" an invention defined by a narrower or more specific claim in another patent, the former "dominating" the latter because the more narrowly claimed invention cannot be practiced without infringing the broader claim . . . . In possibly simpler terms, one patent dominates another if a claim of the first patent reads on a device built or process practiced according to the second patent disclosure. This commonplace situation is not, per se, double patenting as the [Examiner] seemed to think. *Id.* at 681.

In brief, the presence of dominating claims is not a determining factor in an obviousness-type double patenting rejection. For at least this reason, the rejection as it applies to claim 1 is improper because claim 1 is a dominant claim.

Additionally, on page 2, paragraph 3, in the Office Action, the U.S. Patent and Trademark Office (USPTO) states that although the conflicting claims are not identical, they are not patentably distinct from each other because the present application is a broader version of the patented claims. It is respectfully submitted that the USPTO recognizes that the present application includes dominant claims which, for the reasons set forth above, do not, per

se, violate the rule against double patenting.

Furthermore, double patenting is concerned with attempts to claim related subject matter twice. Double patenting does not prohibit a later claiming of subject matter that is disclosed but not claimed in an earlier patent. In re Gibbs, 437 F.2d 486, 168 USPQ 578 (CCPA 1971). The issue regarding the judicially created doctrine of obviousness-type double patenting is whether any claim of the application defines merely an obvious variation of an invention claimed in the earlier patent.

The '653 patent is also directed to a communications system. Claim 2, for example recited in the '653 patent, relates to a communications system that includes a PSTN, a data network, at least two central office switching systems, means for establishing a data transmission pipeline, means for continually monitoring transmission traffic conditions and means for routing voice call data packets. The PSTN has plurality of interconnected central office switching systems with each one connected to at least one subscriber line. The data network which is separate from the switched telephone network includes multiple remotely spaced routers for linking together paths of the data network using transmission control protocols to provide connectionless packet service between remote locations of the data network.

The at least two central office switching systems recited in claim 2 of the '653 patent are connected to a respective interface to the data network. The central

office switching systems provide selective connection between the interfaces and the subscriber lines connected to each of the central office switching systems. The means for establishing the data transmission pipeline is established through the switched telephone network between the two interfaces thereby bypassing the separate data network. The means for continually monitoring transmission traffic conditions is in a separate data network and determines whenever data traffic conditions therein are below a predetermined acceptable threshold level. The means for routing the voice call data packets occurs through the pipeline between the two interfaces in response to each determination by the monitoring means that data traffic conditions in the separate data network are below the predetermined acceptable threshold level and routes voice call data packets through the separate data network in absence of such determination.

Claim 21 of the application is directed to a communications network that includes a switched telecommunications network, a separate control network, a data network separate from the switched telephone network and at least two central office switching systems. An interface is connected to the at least two of the central office switching systems. Claim 21 recites that each interface includes a capability to invoke a quality test application for determining the quality of service in the data network. Claim 21 also recites that the separate

control network includes a common channel interoffice signaling network that has signal transfer points connected to the central office switching systems through signal switching points via links between the signal switching points and signal transfer points.

It is respectfully submitted that the '653 patent fails to claim features recited in claim 21. Specifically, the '653 patent fails to claim a separate control network that includes a common channel interoffice signaling network as recited in claim 21. Also, the '653 patent fails to claim a common channel interoffice signaling network that has signal transfer points connected to the central office switching systems through signal switching points via links between the signal switching points and the signal transfer points. Also, the '653 patent fails to claim interfaces, each of which includes a capability to invoke a quality test application for determining the quality of service in the data network. Because the '653 patent fails to recite these features, claim 21 cannot be construed as an obvious variation of the claimed subject matter in the '653 patent.

The '653 patent also fails to claim features recited in the dependent claims of the application. For instance, claim 2 recites a unique service code. Claim 3 recites completing the telephone call to a second station through an interexchange carrier switching network. Claim 4 recites that the PSTN is an advance intelligent network. Claim 5 recites an interexchange carrier identity. Claim 6 recites

that the routing step includes exchanging signaling messages between the public switched telephone networks and the data packet network through interfaces. Claim 8 recites the step of determining that the destination station is not busy. Claim 9 recites that a comparing step includes retrieving a stored threshold value from the subscriber CPR of the calling station. Claim 10 recites the step of triggering an ISCP in response to input of the unique service code at the calling station. Claim 11 recites the step of triggering the ISCP in response to an off hook condition at the calling station. Claim 12 recites the step of ascertaining if dialed information received from the calling station corresponds to information stored in the subscriber CPR for the calling station. Claim 13 recites that the dialed information is area code. Claim 14 recites that the dialed information is destination telephone number. Claim 16 recites the step of successively measuring the round trip time duration between each data packet transmitted in the transmitting step and receipt of its corresponding response packet. Claim 17 recites that the threshold value is exceeded if the time duration measured in the measuring step is less than a stored value in the calling station CPR. Claim 18 recites that the threshold level is exceeded if the variance in the ascertaining step is less than a stored value in the calling station CPR.

Claim 19 recites the step of transmitting at least one sample packet to the data packet network that requests

reservation of a minimum bandwidth level. Claim 20 recites that the threshold level is a predetermined bandwidth level. Claim 22 recites selectively routing a voice call originating from a first central office switching system. Claim 24 recites a processor having router and packet assembler and disassembler capabilities.

Claims 2-20 depend from claim 1 and include all of the features of claim 1. Claims 22-24 depend from claim 21 and include all of the features of claim 21. Because claims 2-6, 8-14, 16-20, 22 and 24 include the features not claimed in the '653 patent, the rejection is improper as it applies to these claims.

Withdrawal of the rejection is respectfully requested.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited.

Any fees associated with the filing of this paper should be identified in any accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer, PLLC.

Respectfully submitted,

Date: 2 April 2002

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Enclosure(s): Marked-Up Version of Amended Specification

MARKED-UP VERSION OF AMENDED SPECIFICATION

On Page 1, Paragraph 1:

This application is related to [application Serial No. 08/6345,544] U.S. Patent No. 5,790,548, entitled Universal Access Multimedia Network, [filed April 18, 1996] issued August 4, 1998, application Serial No. 08/634,543, entitled Internet Telephone Service, filed April 18, 1996 and [application Serial No. 08/670,908] U.S. Patent No. 6,069,890, entitled Internet Telephone System, [filed June 28, 1996] issued May 30, 2000. The specification of [those] the application[s] and patents are incorporated herein by reference in their entirety.

On Page 7, Paragraph 4:

The commonly assigned [applications, Serial Nos. 08/634,543 and 08/670,908] application Serial No. 08/634,543 and U.S. Patent No. 6,069,890, identified more particularly above, are concerned with providing telephone service via the Internet to users of the public telecommunications network who may not have access to a computer or separate telephone access to the Internet. Such service would be economical, especially for long distance calls, compared with the toll rates charged by long distance interexchange carriers.